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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,738	03/30/2005	Yasuyuki Mizuno	511.44961X00	1963

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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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08/12/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dlee@antonelli.com
rrodriguez@antonelli.com
lthenor@antonelli.com

Office Action Summary	Application No. 10/529,738	Applicant(s) MIZUNO ET AL.	
	Examiner ROBERT SELLERS	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 11-49 and 56-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 50-55 and 87-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-9, 11-16, 18-30, 32-43, 45-49, 56-59, 66-69, 76-79 and 81-86 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

Claims 17, 31, 44, 60-65, 70-75 and 80 are withdrawn as directed to nonelected species. The election was made **without** traverse in the reply filed on November 13, 2007.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed December 10, 2007.

Claims 10, 50-55 and 87-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Publication No. WO 01/70885 as represented by Mizuno et al. Patent No. 7,157,506.

The rejection is maintained for the reasons of record set forth in the previous Office actions. The arguments filed June 16, 2009 have been considered but are unpersuasive.

2. None of the examples cited in the declaration filed June 16, 2009 nor those of the specification in Tables 1 (page 48), 3 (page 59), 5 (page 70) and 7 (page 81) address the criticality of the claimed from 10 to 250 parts by weight per 100 parts by weight of the cyanate ester compound of biphenyl epoxy resin via a direct comparison with an equivalent amount of the closest prior art brominated bisphenol A epoxy resin ESB400T shown in Example 19 (col. 40) of Mizuno et al. wherein the types and amount of all other components are held constant.

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3. Mizuno et al. specifically discloses a biphenyl epoxy resin (col. 16, line 63, epoxy resin (H) according to col. 15, lines 40-43) but exemplifies a brominated bisphenol A epoxy resin. It would have been obvious to incorporate the epoxy resin (H) such as the biphenyl epoxy resin designated in Mizuno et al. in order to optimize the dielectric properties and heat resistance.
4. The declaration pertains to the criticality of the claimed proportion range of two types of biphenyl epoxy resin but does not compare them to the brominated bisphenol A epoxy resin ESB400T of Mizuno et al. The combination of ESB400T and YX4000 tetramethylbiphenyl epoxy resin in Example 16 of Table 5 is not representative of the closest prior art formulation with ESB400T alone.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Division 1796

rs
8/7/2009